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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,628	10/19/2001	Amr Salahieh	1001.1506101	1079
28075	7590	05/04/2004	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC			NGUYEN, VI X	
1221 NICOLLET AVENUE			ART UNIT	
SUITE 800			PAPER NUMBER	
MINNEAPOLIS, MN 55403-2420			3731	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/045,628

Applicant(s)

SALAHIEH ET AL.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 and 42-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/02 and 02/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, Species V of claims 36-41 in 3/18/2004 is acknowledged. Claims 1-35 and 42-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in 3/18/2004.

### **Claim Objections**

2. Claim 36 recites "an elongate shaft" line 4 instead of -- the elongate shaft--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36 and 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Khosravi (U.S. 6,129,739) as cited in Applicant's IDS.

Khosravi discloses in figs. 5a-5d, a device is used for filtering or removing matter within a vascular system having the limitations of claim 36, including: an elongate shaft (40); the shaft defines a filter lumen and a guide wire lumen (22). A filter assembly (28) includes an elongate

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shaft (44, fig. 5d); and wherein the filter disposes on the filter assembly as best seen on figures 5a-b. The filter is disposed in part within the filter lumen (see col. 7, lines 39-50).

Regarding claims 38-39, Khosravi discloses the distal end of the filter lumen includes a filter-containing region (24); and wherein the filter is disposed within the containing region.

Regarding claims 40-41, Khosravi discloses in fig. 5a having a guidewire lumen disposed proximally and distally of the filter containing region. The filter-containing region has a larger diameter than an alternate portion of the filter lumen. The guide wire lumen is at least in part discontinuous at the filter-containing region as best seen on figs. 5a, 5c. Furthermore, the guide wire (22) is disposed in a guide wire lumen.

Claims 36 –41 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsugita (U.S. 6,142,987) as cited in Applicant's IDS.

Tsugita discloses in figs. 1G,J,K, a device is used for capturing embolic material within a vascular system having the limitations of claim 36, including: an elongate shaft (79); the shaft defines a filter lumen and a guide wire lumen (30). A filter assembly (20) includes an elongate shaft (75); and wherein the filter disposes on the filter assembly as best seen on figure. 1K. The filter is disposed in part within the filter lumen (51).

Regarding claim 37, the guide wire lumen (30) of Tsugita can be considered as shorter than the filter lumen as best seen in fig. 1G.

Regarding claims 38-39, Tsugita discloses the distal end of the filter lumen includes a filter-containing region (25); and wherein the filter is disposed within the containing region.

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Regarding claims 40-41, Tsugita discloses in fig. 1K having a guidewire lumen disposed proximally and distally of the filter-containing region. The filter-containing region has a larger diameter than an alternate portion of the filter lumen. The guide wire lumen is at least in part discontinuous at the filter-containing region as best seen on fig. 1j. Furthermore, the guide wire (70) is disposed in a guide wire lumen.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,179,861 to Khosravi

U.S. Pat. No. 5,769,816 to Barbut

U.S. Pat. No. 5,814,064 to Daniel

U.S. Pat. No. 6,616,682 to Joergensen


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn *VN*  
April 27, 2004

  
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